


PATENT

MS147249.01/MSFTP102US

CERTIFICATE OF FACSIMILE TRANSMISSION

I hereby certify that this correspondence (along with any paper referred to as being attached or enclosed) is being faxed to 703-872-9306 on the date shown below to Mail Stop Appeal Briefs – Patents, Commissioner for Patents, P.O. Box 1450, Alexandria, Virginia 22313-1450.

Date: 1-18-05
Himanshu S. Amin

Jan 18 2005

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

In re patent application of:

Applicant(s): Lucius Merideth, *et al.*

Examiner: Trenton J. Roche

Serial No: 09/560,371

Art Unit: 2124

Filing Date: April 28, 2000

Title: BINDING FOR BUSINESS WORKFLOW PROCESSES

Mail Stop Appeal Brief – Patents
Commissioner for Patents
P.O. Box 1450
Alexandria, Virginia 22313-1450

APPEAL BRIEF

Dear Sir:

Applicant's representative submits this brief in connection with an appeal of the above-identified patent application. A credit card payment form is filed concurrently herewith in connection with all fees due regarding this appeal brief. In the event any additional fees may be due and/or are not covered by the credit card, the Commissioner is authorized to charge such fees to Deposit Account No. 50-1063 [MSFTP102US].

00000036 09560371

01/19/2005 10:00 AM

500.00 OP

01 FC:1401

09/560,371

MS147249.01/MSFTP102US

I. Real Party in Interest (37 C.F.R. §41.37(c)(1)(i))

The real party in interest in the present appeal is Microsoft Corporation, the assignee of the present application.

II. Related Appeals and Interferences (37 C.F.R. §41.37(c)(1)(ii))

Appellants, appellant's legal representative, and/or the assignee of the present application are not aware of any appeals or interferences which may be related to, will directly affect, or be directly affected by or have a bearing on the Board's decision in the pending appeal.

III. Status of Claims (37 C.F.R. §41.37(c)(1)(iii))

Claims 1-28 stand rejected by the Examiner. Claims 1-7 and 26-28 have been cancelled. The rejection of claims 8-25 is being appealed.

IV. Status of Amendments (37 C.F.R. §41.37(c)(1)(iv))

Claims 1-7 and 26-28 were cancelled after the Final Office Action.

V. Summary of Claimed Subject Matter (37 C.F.R. §41.37(c)(1)(v))**A. Independent Claim 8**

Independent claim 8 recites a system that facilitates modeling of business processes that are associated with a plurality of business operations, the system comprises a computer-readable medium and a plurality of computer-executable files, which include a scheduling component that employs a dataflow diagram to define a flow of business operations, the dataflow diagram includes actions coupled *via* data flowing between them and a binding component that defines the business operations through a schedule message, a port connection, a port and a message interface with a component outside of the schedule. (See p.3, ll.22-27, p.15, ll.14-15, and p.15, ll.21-23).

B. Independent Claim 16

Independent claim 16 recites a system that facilitates modeling of business processes that include a plurality of business operations, the system comprises a

09/560,371

MS147249.01/MSFTP102US

computer-readable medium and a plurality of computer-executable files, which comprise a scheduling component that defines the flow of business operations in a schedule and a binding component that separates the schedule from implementations of a workflow and maps actions in the schedule to calls on at least one technological component. (See p.4, ll.3-8 and p.16, ll.13-17).

C. Independent Claim 22

Independent claim 22 recites a computer implemented business process scheduling software that comprises a data flow module that allows a user to define a flow of business operations in a file that is utilized with a plurality of disparate business implementations and a binding module that allows a user to define a link between the file with business operations and the plurality of disparate business implementations. (See p.4, ll.9-12 and p.16, ll.17-28).

VI. Grounds of Rejection to be Reviewed (37 C.F.R. §41.37(c)(1)(vi))

A. Claims 8-15 and 22-25 stand rejected under 35 U.S.C. §103(a) as being unpatentable over WfMC in view of "Executable Workflows: A Paradigm for Collaborative Design on the Internet" by Lavana, *et al.*

B. Claims 16-21 stand rejected under 35 U.S.C. §102(b) as being anticipated by "A Common Object Model Discussion Paper" by the Workflow Management.

VII. Argument (37 C.F.R. §41.37(c)(1)(vii))

A. Rejection of Claims 8-15 and 22-25 Under 35 U.S.C. §103(a)

Claims 8-15 and 22-25 stand rejected under 35 U.S.C. §103(a) as being unpatentable over "A Common Object Model Discussion Paper" by the Workflow Management Coalition (hereafter "WfMC") in view of "Executable Workflows: A Paradigm for Collaborative Design on the Internet" by Lavana, *et al.* (hereafter "Lavana, *et al.*"). It is respectfully submitted that this rejection should be withdrawn for the following reasons. WfMC and Lavana, *et al.*, individually and in combination, do not teach or suggest all elements of the subject claims.

09/560,371

MS147249.01/MSFTP102US

To reject claims in an application under §103, an examiner must establish a *prima facie* case of obviousness. A *prima facie* case of obviousness is established by a showing of three basic criteria. First, there must be some suggestion or motivation, either in the references themselves or in the knowledge generally available to one of ordinary skill in the art, to modify the reference or to combine reference teachings. Second, there must be a reasonable expectation of success. Finally, the prior art reference (or references when combined) must teach or suggest all the claim limitations.

Independent claim 8 recites a scheduling component that employs *a dataflow diagram that defines a flow of business operations and includes actions coupled via data flowing between them*, and a binding component that *defines business operations through a schedule message, a port connection, a port and a message interface* with a component outside of the schedule. The Examiner concedes WfMC does not teach or suggest a dataflow diagram, but contends that Lavana, *et al.* teaches such aspects and that it would have been obvious to one of ordinary skill in the art at the time of the invention to combine WfMC and Lavana, *et al.* to teach the subject claim. The Examiner references Figures 2 and 6 of Lavana, *et al.* to support this contention. However, neither Figure 2 nor Figure 6 is a dataflow diagram that defines a flow of business operations or includes actions coupled *via* data flowing between them as recited in the subject claim. Rather, Figure 2 describes an "Internet-based workflow" that implements a "recursive application of a bi-partitioning tool that partitions a large netlist into a tentative partition and a remainder," and Figure 6 describes a template editor with a partitioner program node with data file dependencies. The Examiner further contends that WfMC teaches a binding component that defines business operations through a schedule message, a port connection, a port and a message interface with a component outside of the schedule. The Examiner references page 8, section 3.1, and page 7, section 2.2.2, of WfMC to support this contention. However, these sections of WfMC are silent regarding defining business operations through a schedule message, a port connection, a port and a message interface.

09/560,371

MS147249.01/MSFTP102US

Independent claim 22 recites *a binding module that allows a user to define a link between the file with business operations and the plurality of disparate business implementations*. The Examiner asserts that WfMC teaches a binding module that allows a user to define a link between a file with business operations and a plurality of disparate business implementations. The Examiner references page 8, section 3.1, and page 7, section 2.2.2, of WfMC to support this assertion. However, these sections do not mention a binding module, disparate business implementations, or a user defined link between business operations or disparate business implementations as recited in the subject claim.

Claim 25 (which depends from independent claim 22) further recites that *the link* is in a programmable language with *XML syntax*. The Examiner asserts that WfMC discloses that XML “may” have a role in the ability to transfer a business project as a work on and that it would have been obvious to one of ordinary skill in the art at the time of the invention to use XML as disclosed by WfMC to teach the subject claim. Applicants’ representative respectfully disagrees. WfMC states that “[a] dynamic form of binding a (sub-)process to a service provider organisation is desirable to provide this flexibility. The implication is that some form of standardised representation of the operational business process instance is required ... [*a non-trivial problem; note that XML may also have a role to play in this area*].” (See p. 9, §3.2). From this excerpt, it is readily apparent that WfMC renders an opinion based on an alleged desire and concedes that this is an unsolved “non-trivial problem,” noting that XML “may” have a role to play in this area. There is no teaching or suggestion in WfMC to use XML to result in the subject claim or a reasonable expectation of success of the purported modification, and a teaching or suggestion, or a reasonable expectation of success must be found in the cited references, not in applicants’ disclosure, in order to render the claim obvious. (See *In re Vaeck*, 947 F.2d 488 (Fed. Cir. 1991)). The mere fact that the reference can be modified does not render the modification obvious unless the referenced art also suggests the desirability of the modification. (See *In re Mills*, 916 F.2d 680 (Fed. Cir. 1990)).

09/560,371

MS147249.01/MSFTP102US

B. Rejection of Claims 16-21 Under 35 U.S.C. §102(b)

Claims 16-21 stand rejected under 35 U.S.C. §102(b) as being anticipated by WfMC. It is respectfully submitted that this rejection should be withdrawn for at least the following reasons. WfMC does not teach or suggest each and every limitation as set forth in the subject claims.

A single prior art reference anticipates a patent claim only if it expressly or inherently describes each and every limitation set forth in the patent claim. *Trintec Industries, Inc. v. Top-U.S.A. Corp.*, 295 F.3d 1292, 63 U.S.P.Q.2D 1597 (Fed. Cir. 2002). "A claim is anticipated only if each and every element as set forth in the claim is found, either expressly or inherently described in a single prior art reference." *Verdegaal Bros. v. Union Oil Co. of California*, 814 F.2d 628, 631, 2 USPQ2d 1051, 1053 (Fed. Cir. 1987). "The identical invention must be shown in as complete detail as is contained in the ... claim." *Richardson v. Suzuki Motor Co.*, 868 F.2d 1226, 9 USPQ2d 1913, 1920 (Fed. Cir. 1989).

Independent claim 16 recites a binding component that separates a schedule (the schedule includes a definition of a flow of business operations) from implementations of a workflow and *maps actions in the schedule to calls on at least one technological component*. The Examiner asserts WfMC teaches such claimed aspects and references page 8, section 3.1 of WfMC to support this assertion. The Examiner contends that this section of WfMC states "[t]he ability to establish dynamic bindings with location service between different workflow components or between different workflow services..." Applicants' representative respectfully disagrees. Rather, section 3.1 of WfMC states "[t]he ability to establish dynamic bindings with location service between different workflow components or between different workflow services ... will become increasingly important...." From this excerpt, it is readily apparent that the Examiner has referenced section 3.1 of WfMC out of context. WfMC does not teach dynamic bindings. Instead, WfMC simply opines that dynamic bindings will become important in the future and does not provide any enabling disclosure for dynamic bindings. Thus, this rejection is improper. (See *In re Donohue*, 766 F.2d 531, 533 (Fed. Cir. 1985) (stating that it is

09/560,371

MS147249.01/MSFTP102US

well settled that prior art under 35 U.S.C. §102 must sufficiently describe the claimed invention and that even if the claimed invention is disclosed that disclosure will not suffice as prior art if it was not enabling)). Moreover, section 3.1 of WfMC relates to bindings "between workflow components" or "between workflow services." In contrast, independent claim 16 recites mapping actions in a schedule to calls on a technological component. The Examiner asserts that bindings between workflow services of WfMC inherently teach links between such services and technological components. Applicants' representative respectfully disagrees and submits that the relationships between workflow services describes that class of relationships – between workflow services – but does not teach or suggest, inherently or expressly, mapping actions in a schedule to calls on a technological component as recited in the subject claims.

C. Conclusion

For at least the above reasons, the claims currently under consideration are believed to be patentable over the cited references. Accordingly, it is respectfully requested that the rejections of claims 8-25 be reversed.

If any additional fees are due in connection with this document, the Commissioner is authorized to charge those fees to Deposit Account No. 50-1063.

Respectfully submitted,
AMIN & TUROCY, LLP



Himanshu S. Amin
Reg. No. 40,894

AMIN & TUROCY, LLP
24TH Floor, National City Center
1900 E. 9TH Street
Cleveland, Ohio 44114

Telephone (216) 696-8730
Facsimile (216) 696-8731

09/560,371

MS147249.01/MSFTP102US

VIII. Claims Appendix (37 C.F.R. §41.37(c)(1)(viii))

1-7 Cancelled

8. A system that facilitates modeling of business processes comprised of a plurality of business operations, comprising:

a computer-readable medium; and

a plurality of computer-executable files comprising:

a scheduling component that employs a dataflow diagram to define a flow of business operations, the dataflow diagram includes actions coupled *via* data flowing between them; and

a binding component that defines the business operations through a schedule message, a port connection, a port and a message interface with a component outside of the schedule.

9. The system of claim 8, the binding component further defines technology specific information for binding business operations to at least one technological component.

10. The system of claim 8, the binding component binds a single business operation to a plurality of technological components.

11. The system of claim 8, further comprising a binding file that provides port and message mapping between business operations and between business operations and technological components.

12. The system of claim 8, the binding component further defines message structure and declares messages.

13. The system of claim 8, the binding component further defines context semantics.

14. The system of claim 8, the binding component further defines schedule conditionals.

09/560,371MS147249.01/MSFTP102US

15. The system of claim 8, further including a second binding component that binds the business operations with a second component outside of the schedule.
16. A system for facilitating modeling of business processes comprised of a plurality of business operations, the system comprising a computer-readable medium and a plurality of computer-executable files comprising:
- a scheduling component that defines the flow of business operations in a schedule; and
 - a binding component that separates the schedule from implementations of a workflow and maps actions in the schedule to calls on at least one technological component.
17. The system of claim 16, the binding component binds a single business operation to a plurality of technological components.
18. The system of claim 16, business operations are actions connected by data flowing between them and actions are ports and messages wherein a binding file provides virtual port and message mapping between business operations and between business operations and technological components.
19. The system of claim 16, the binding component further defines message structure and declares messages.
20. The system of claim 16, the binding component further defines context semantics.
21. The system of claim 16, the binding component further defines schedule conditionals.

09/560,371MS147249.01/MSFTP102US

22. A computer implemented business process scheduling software comprising:
a data flow module that allows a user to define a flow of business operations in a file that is utilized with a plurality of disparate business implementations; and
a binding module that allows a user to define a link between the file with business operations and the plurality of disparate business implementations.
23. The software of claim 22, the binding module further allowing the user to specify the business implementation to apply to a business process.
24. The software of claim 22, the binding module further allowing the user to specify programmable semantics of the data flow module.
25. The software of claim 22, the link is provided in a programmable language having XML syntax.
- 26-28 Cancelled